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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,297	10/27/2003	Peter J. Dronzek	18-018B	3580
47888	7590	08/05/2005	EXAMINER	
HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 08/05/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/694,297

Applicant(s)

DRONZEK, PETER J.

Examiner

Daniel Zirker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/948,916.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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1. The abstract of the disclosure is objected to because In its present form it is entirely directed to the process invention, whereas the present application is almost entirely directed to a genus of claimed articles having a particular genus of labels adhered thereon.. Correction is required. See MPEP § 608.01(b).

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 23-48 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the claimed process invention, such as now set forth in claims 49 and 50, as well as in the two parent applications, does not reasonably provide enablement for article claims 23-48, since the entire specification appears to be totally directed to the various process inventions, and essentially does not discuss the newly claimed article inventions. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. For example, the Examiner has been unable to find a disclosure of either independent claim 23 or 27 in the specification; e.g. where does express support for "dried water based adhesive" in the article of claim 23 and the "dried hydrophilic layer which was remoistened prior to application to said container" in claim 27 exist? It is also pointed out that nowhere has applicant set forth where in the specification for any of the article claims finds support...

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 23-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, there appears to be a significant number of informalities in the newly presented article claims and the Examiner will attempt to point out as many as possible, although some may be overlooked and applicant is urged to correct them. In each of the independent article claims 23 and 27 the specific order of the layers is not set forth and is not believed to be routinely obvious. Claims 24, 31 and 46 lack proper Markush language. Claim 30 is grammatically improper. In claim 36 "less adhesive" has no applicable standard to refer to for determination, and claim 37 uses Markush language but has only one species in the group. Claims 41 and 42 appear to lack antecedent basis for "printed indicia", as does "exposed" polymer layer in claims 43 and 44; also in claim 44 "antistatic agents known to those in the art" is vague and indefinite. Finally, in claim 48 "having as defined in claim 29" is clearly vague and indefinite.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 23, 27, 28, 31, 34 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Auslegeschrift 1 569 879. Note the entire disclosure of the translation, particularly the Abstract, page 3, first two complete paragraphs, page 4, second complete paragraph – page 5, line 6, page 5, bottom paragraph.

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 24-26, 29, 30, 32, 33, 35-46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aus '879. The reference is again relied upon substantially as set forth above, disclosing, in certain embodiments, a metal, glass or plastic container having a suitable plastic label adhered thereto by a hydrophilic polymeric material containing carboxy groups such as a suitable polyacrylic acid, which may either function as a primer or as an aqueous based adhesive, but is itself desirably coated with a conventional aqueous based, quick drying adhesive known to those skilled in the art., which is substantially all the great majority of applicant's claims require. With respect to certain of the dependent claims not encompassed by the above analysis, such parameters as the specific polymeric label backing, whether the hydrophilic layer contains printing, slip agents, antistatic agents and other conventional additives, and whether or not the aqueous adhesive contains, e.g. (claim 46) starch, casein, synthetic polymers or the like (note also as evidence of the state of the art for this last claim, Herlfterkamp et al) are each believed to be, if not expressly or inherently set forth, obvious modifications to one of ordinary skill, in the absence of unexpected results.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 49 and 50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 6,306,242. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed step of applying water to the hydrophilic layer in pending claim 49 is not seen to be significantly different from the step of applying an aqueous adhesive layer to the hydrophilic layer as set forth in the patent claims.

11. Claims 49 and 50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,663,746. Although the conflicting claims are not identical, they are not patentably distinct from each other because the logic used in the preceeding paragraph against US Patent 6,306,242 is again believed to be clearly applicable.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Beery, Jannusch, Tung and Mitchell et al.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Zirker  
Primary Examiner  
Art Unit 1771

A handwritten signature in black ink that reads "Daniel Zirker". The signature is written in a cursive, flowing style.